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APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. CONFIRMATION	
09/660,852	09	/13/2000	Gerard Vahee	END920000075US1	7942
7590 01/25/2005			EXAMINER		
John R. Pivni	chny		FRENEL, VANEL		
IBM, N50/040- 1701 North Str				ART UNIT	PAPER NUMBER
Endicott, NY 13760			·	3626	
				DATE MAILED: 01/25/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<u>/</u> .							
· / \	Appli	cation No.	Applicant(s)				
	09/66	60,852	VAHEE ET AL.				
Office Action Sumn			Art Unit				
		Frenel	3626				
The MAILING DATE of this				ddress			
Period for Reply							
A SHORTENED STATUTORY PE THE MAILING DATE OF THIS CO - Extensions of time may be available under the after SIX (6) MONTHS from the mailing date of - If the period for reply specified above is less that - If NO period for reply is specified above, the no - Failure to reply within the set or extended perion - Any reply received by the Office later than three earned patent term adjustment. See 37 CFR	DMMUNICATION.  provisions of 37 CFR 1.136(a). In r of this communication.  nan thirty (30) days, a reply within the  naximum statutory period will apply a  od for reply will, by statute, cause the  months after the mailing date of the	no event, however, may a reply be tire e statutory minimum of thirty (30) day nd will expire SIX (6) MONTHS from the application to become ABANDONE	mely filed /s will be considered time the mailing date of this of ED (35 U.S.C. § 133).	ely. communication.			
Status							
1) Responsive to communicati	on(s) filed on <u>12 Novemb</u> e	<u>er 2004</u> .					
2a)☐ This action is <b>FINAL</b> .	<b>,—</b>						
• • • • • • • • • • • • • • • • • • • •	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
closed in accordance with tr	ie practice under <i>Ex parte</i>	( Quayle, 1935 C.D. 11, 4	53 U.G. 213.				
Disposition of Claims							
4)	is/are withdrawn from ed. I. ed to.						
Application Papers							
9) The specification is objected 10) The drawing(s) filed on Applicant may not request that Replacement drawing sheet(s) 11) The oath or declaration is ob	_ is/are: a) ☐ accepted of any objection to the drawing including the correction is re	(s) be held in abeyance. Se quired if the drawing(s) is ob	e 37 CFR 1.85(a). ojected to. See 37 C	• •			
Priority under 35 U.S.C. § 119			•				
<ul><li>2. Certified copies of the</li><li>3. Copies of the certified</li></ul>	ne of: priority documents have priority documents have copies of the priority doc nternational Bureau (PCT	been received. been received in Applicat uments have been receive Rule 17.2(a)).	ion No ed in this Nationa	l Stage			
Attachment(s)							
1) Notice of References Cited (PTO-892)		4) Interview Summary					
Notice of Draftsperson's Patent Drawing     Information Disclosure Statement(s) (PTo Paper No(s)/Mail Date		Paper No(s)/Mail D 5) Notice of Informal F 6) Other:		O-152)			

#### **DETAILED ACTION**

# Notice to Applicant

1. This communication is in response to the RCE filed 11/12/04. Claims 1-12 are pending. No claims have been added.

### Claim Rejections - 35 USC § 103

- 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baer et al (6,611,840) in view of Morgenthaler et al (2002003277), for substantially the same reasons given in the previous Office Action.

#### 1.131 Affidavit

4. Applicant has submitted an Affidavit to remove Baer (6,611,840) in view of Morgenthaler (2002/0032677) as references applied under 35 U.S.C. § 103(a) in the previous Office Actions. The Affidavit filed on 04/08/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Baer and Morgenthaler references for the following reasons:

(A) According to MPEP § 715.07, Applicant should specifically refer to each exhibit relied upon in the affidavit or declaration, in terms of what it is relied upon to show. The affidavit or declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

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In this case, Applicant states in the declarations generally state that the claimed invention was reduced to practice in October/November 1999. However, an explanation as to how specific facts presented within the provided evidence relate to the claimed limitations is not present.

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An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). MPEP 2138.05.

## Response to Arguments

5. Applicant has only presented arguments pertaining to the affidavit. The issues related to the affidavit have been addressed above in section 4. Applicant has not presented any additional arguments.

# Conclusion

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6. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vanel Frenel whose telephone number is (703) 305-

4952. The Examiner can normally be reached on Monday-Thursday from 6:30am -

5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Receptionist whose telephone number is (703)

306-1113.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326

[Official communications]

(703) 872-9327

[After Final communications labeled "Box AF"]

(703) 746-8374

[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,

Arlington, VA, 7th Floor (Receptionist).

January 21, 2005

ALEXANDER KALINUWSKI PRIMARY EXAMINER